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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,383	09/04/2003	Josef Wagner	35369US1	6567

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EXAMINER

BRINEY III, WALTER F

ART UNIT PAPER NUMBER

2646

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/655,383

Applicant(s)

WAGNER, JOSEF

Examiner

Walter F. Briney III

Art Unit

2646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/27/06; 9/22/03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 7-10 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse by the applicant's representative Michael Garvey, Reg. No. 35878, during a series of telephonic interviews throughout the week of February 19, 2006.

### ***Inventorship***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Luethi (US Patent 4,918,737).**

**Claim 1** is limited to “a remote control unit for wireless control of an electrical microdevice.” Luethi discloses a hearing aid with wireless remote control. See Abstract. As seen in figure 1, and as explained in column 4, lines 12-57, a watch (i.e. “an object worn or carried by a person) including “a band” 7 is integrated with “electronic circuitry” for remotely controlling a hearing aid. One such electronic circuit is illustrated as modulator 16. The fact that the circuitry of Luethi is either integrated within the watch (figure 1) or provided in an auxiliary housing (column 4, lines 47-52) that plugs onto the watch results in an attachment to the band. Therefore, Luethi anticipates all limitations of the claim.

**Claim 12** is limited to “the remote control unit as in claim 1,” as covered by Luethi. Luethi discloses controlling a hearing aid with the remote control. See Abstract. Therefore, Luethi anticipates all limitations of the claim.

**Claim 13** is limited to “the remote control unit as in claim 1,” as covered by Luethi. Luethi discloses controlling “a hearing aid” with the remote control. See Abstract. Therefore, Luethi anticipates all limitations of the claim.

**Claim 14** is limited to “the remote control unit as in claim 1,” as covered by Luethi. Luethi discloses controlling a hearing aid (i.e. “a medical device”) control. See Abstract. Therefore, Luethi anticipates all limitations of the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2646

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 2, 5, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luethi in view of Locher et al. (US Patent 6,126,078).**

**Claim 2** is limited to “the remote control unit as in claim 1,” as covered by Luethi.

Luethi discloses that the electronic components are to be provided in an auxiliary housing which can be plugged onto a commonly worn article, such as a wristwatch.

See column 4, lines 47-52. Clearly, the auxiliary housing corresponds to “a housing separate from the object and having the electronic circuitry contained therein.”

However, there is no clear indication that the auxiliary housing disclosed by Luethi “provides attachability to the band.” However, this deficiency is overcome by an obvious modification.

In particular, it is noted that because Luethi is silent regarding the means in which the auxiliary housing is to be “plugged onto” an existing watch, one of ordinary skill in the art would have been inherently motivated to provide such means. Locher teaches one such means in figures 18a, 18b and 19 thereof. As seen in the cross-section of figure 18b, an auxiliary housing 3 is provided with overlapping legs 8 that wrap around a band PA. As the legs are integrated with the housing 3 that contains the electronics MI, it follows that the housing provides “attachability to a band.” See column 8, line 62, through column 9, line 67.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the auxiliary housing as taught by Locher simply because Luethi is

completely silent regarding the structure of a housing comprising electronic components and the means in which said housing is to be connected to a watch band.

**Claim 5** is limited to "the remote control unit as in claim 2," as covered by Luethi in view of Locher. While figures 18a, 18b and 19 do not show the following, Locher teaches clipping carrier device 1, including circuitry MI, onto a band using four elastic tabs. See column 9, lines 50-53. The tabs correspond to "spring clips or clamp-like sections for detachable mounting on said band." Therefore, Luethi in view of Locher makes obvious all limitations of the claim.

**Claim 6** is limited to "the remote control unit as in claim 2," as covered by Luethi in view of Locher. While figures 18a, 18b and 19 do not show the following, Locher teaches clipping carrier device 1, including circuitry MI, onto a band using four elastic tabs. See column 9, lines 50-53. The tabs correspond to "means for detachably mounting on the band." Therefore, Luethi in view of Locher makes obvious all limitations of the claim.

**Claim 11** is limited to "the remote control unit as in claim 1," as covered by Luethi. Apropos the rejection of claim 2, it would have been obvious to provide the auxiliary housing of Luethi in the manner taught by Locher. Locher teaches electronic circuitry MI that is "centrally located" in a housing 3. The housing 3 includes several plastic legs 8 (i.e. "elastomeric polymer or a rubber-like material) that include Velcro, thus enabling the fitting of housing 3 to bands of different sizes. See column 8, line 62, through column 9, line 47. Therefore, Luethi in view of Locher makes obvious all limitations of the claim.

3. **Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luethi in view of Loizeaux (US Patent 4,993,004).**

**Claim 2** is limited to “the remote control unit as in claim 1,” as covered by Luethi. Luethi discloses that the electronic components are to be provided in an auxiliary housing which can be plugged onto a commonly worn article, such as a wristwatch. See column 4, lines 47-52. Clearly, the auxiliary housing corresponds to “a housing separate from the object and having the electronic circuitry contained therein.” However, there is no clear indication that the auxiliary housing disclosed by Luethi “provides attachability to the band.” However, this deficiency is overcome by an obvious modification.

In particular, it is noted that because Luethi is silent regarding the means in which the auxiliary housing is to be “plugged onto” an existing watch, one of ordinary skill in the art would have been inherently motivated to provide such means. Loizeaux teaches one such means in figures 1-4 thereof. As seen in the top view of figure 4, an auxiliary housing 2 is provided with clips 4 that wrap around a band PA. As the clips are integrated with the housing 2 that contains the electronics (figure 3), it follows that the housing provides “attachability to a band.” See column 3, lines 32-63.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the auxiliary housing as taught by Loizeaux simply because Luethi is completely silent regarding the structure of a housing comprising electronic components and the means in which said housing is to be connected to a watch band.

4. **Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luethi in view of Loizeaux and further in view of Fujisawa et al. (US Patent Application Publication 2002/0107054).**

**Claim 3** is limited to “the remote control unit as in claim 2,” as covered by Luethi in view of Loizeaux. Luethi clearly indicates the necessity of user input 10 in column 4, lines 34-40. It is noted that Loizeaux provides a housing with a touchpad 10 that can be used to provide this functionality. The touchpad 10 corresponds to “user operable operation elements. It is further noted that because Luethi and Loizeaux are not both directed toward remote controls, off-loading the buttons from the watch is not inherent. However, there is motivation in the prior art to do so. In particular, Fujisawa teaches that an electronic package should be provided in a self-contained manner so that any hitherto used watch may be used in connection with the effects of the electronic package. See paragraphs 389-392 and paragraphs 401.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a housing with a touchpad as taught by Loizeaux to realize the advantages taught by Fujisawa.

**Claim 4** is limited to “the remote control unit as in claim 3,” as covered by Luethi in view of Loizeaux and further in view of Fujisawa. It was shown apropos the rejection of claim 3 that the cited prior art makes obvious a “touchpad.” Therefore, Luethi in view of Loizeaux and further in view of Fujisawa makes obvious all limitations of the claim.

### ***Conclusion***



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**

WFB